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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,235	10/11/2000	Frederic L. Way II	TS097-cipSLED	6103

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EXAMINER

KLEBE, GERALD B

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,235

Applicant(s)

WAY ET AL.

Examiner

Gerald B. Klebe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

A.B. Klebe
16 August 2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. The amendment filed 5/24/2004 under 37 CFR 1.111 has been entered. Claims 1-28 are pending in the application. Claims 1-19 having been withdrawn from further consideration, an action on the merits of claims 20-28 follows.

Drawings

2. The replacement drawings filed 5/24/2004 are accepted by the examiner.

Claims Presentation - Revised Amendment Practice

3. The claims as presented in the amendment do not comply with the revised amendment practice 37 CFR 1.121 CHANGED. The revised amendment practice requires that when there is any amendment to a claim, a claim listing of all claims ever presented in the case must be supplied in ascending numerical order and must include: the claim number of every claim ever presented in the application, whether entered or not; a status identifier, in parentheses, following each claim number; the text of all pending claims (including withdrawn claims); and markings to show the changes made only in the current amendment relative to the immediate prior version. compliance is mandatory effective July 30, 2003. Refer to the Flyer H03258.03, Rev. 3 (7/24/03) attached hereto. Since the present amendment appears to be bona fide, the examiner has proceeded with examination on the basis of the claims as presented. However, future amendments to be entered must comply with the revised amendment practice rules in effect.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 20 is rejected under 35 U.S.C. 102 (b) as being anticipated by Volz (US 1409501).

Volz discloses a gravity driven steerable vehicle for use on snow covered terrain comprising: (re: **claim 20**) a chassis (1) having a front, rear , and underside and a topside; a rider riding surface on the top side configured to cause a rider on the surface to be oriented in a prone, face down, face forward position (refer lines 61-66); means (2) for attaching a rear axle assembly (3) substantially at the chassis rear (refer lines 35-37); means (5) for mounting a front axle assembly (6) at the chassis front (refer lines 37-40); means (5) for steering the vehicle by the rider (refer lines 61-66); two rear hub and spindle assemblies (11, 12 and 14 (refer lines 51-57); wherein the ends of the axles 3, 6 serve as spindles (refer lines 42-46)); refer lines 47-48) integral with the rear axle assembly, one rear hub and spindle assembly at each end of the rear axle assembly; and two front hub an spindle assemblies integral with the front axle assembly, one front hub an spindle assembly at each end of the front axle assembly; and means for attaching one ski (10) assembleable to each of the two rear hub and spindle assemblies and to each of the two front hub and spindle assemblies (refer lines 46-61).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 2353501).

As discussed above, Volz discloses all of the features of claim 20 from which claim 21 depends. Volz lacks explicit disclosure of a braking feature.

Redling teaches a snow sled having a manually actuated brake (combination 42, 43, 44).

It would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to incorporate a hand brake in accordance with the teachings of Redling as a safety feature to keep the sled stationary when the rider was entering or exiting from the sled as suggested by the reference at column 1, lines 41-45.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Dandurand (US 2770465).

As discussed above, Volz discloses all of the features of claim 20 from which claim 22 depends. Volz lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of a sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volze to incorporate a harness in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Gibbons (US 6116622).

As discussed above, Volz discloses all of the features of claim 20 from which claim 28 depends. Volz lacks explicit disclosure of a combination roll bar and tote bail for sled.

Gibbons teaches a roll bar and bail (32) for a snow sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to incorporate a combination roll

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bar and tote bail in accordance with the teachings of Gibbons in order to provide safety in case of sled overturning during riding and whereby the sled could be at least partially lifted for transport when not being used.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 2353501) and further in view of Dandurand (US 2770465).

As discussed above, the combination of Volz and Redling discloses all of the features of claim 21 from which claim 23 depends. The combination of Volz and Redling lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of a sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Redling to incorporate a harness in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Redling (US 235501) and further in view of Dandurand (US 2770465).

As discussed above, the combination of Volz and Redling discloses all of the features of claim 22 from which claim 23 depends. The combination of Volz and Redling lacks explicit disclosure of a harness for the rider.

Dandurand teaches a harness (24) for securing a rider onto the riding surface of the sled.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Redling to incorporate a harness for the rider in accordance with the teachings of Dandurand in order to secure the rider onto the riding surface as a safety measure and to provide a more comfortable ride during maneuvers.

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12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Berthold et al. (US 4291892).

As discussed above, Volz discloses all of the features of claim 20 from which claim 24 depends. Volz lacks explicit disclosure of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of Volz to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volz (US 1409501) in view of Dandurand (US 2770465) in further view of Berthold et al. (US 4291892).

As discussed above, the combination of Volz and Dandurand discloses all of the features of claim 22 from which claim 25 depends. The combination of Volz and Dandurand lacks explicit disclosure of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz and Dandurand to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

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14. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Volz (US 1409501) and Redling (US 2353501) in view of Dandurand (US 2770465) and further in view of Berthold et al. (US 4291892).

As discussed above, the combination of Volz, Redling and Dandurand discloses all of the features of claim 23 from which claims 26 and 27 depend. The combination of Volz, Redling and Dandurand lacks explicit disclosure (re: claim 26) of shock absorbing means between the front attached skis and the front axle assembly.

Berthold et al. teaches a gravity driven steerable snow vehicle having shock absorbing means between the front skis and the front axle assembly.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the instant invention was made to have modified the sled of the combination of Volz, Redling and Dandurand to have shock absorbers on the front skis between the skis and the axles in accordance with the teachings of Berthold et al. in order to cushion the ride over uneven terrain as suggested by the reference at column 1, lines 22-27.

Regarding the further limitations of Claim 27, wherein the sled has shock absorbing means between the skis and the axle assembly attached to each of the two rear hub and spindle assemblies, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have further modified the sled having shock absorbing means attached between the skis and axle assemblies at the front of the sled to include, as well, shock absorbing means attached between the skis and axle assemblies at the rear of the sled since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Claims Rejections - Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 20-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, and 9 of U.S. Patent No. 6,276,700 in view of Volz (US 1,409,501).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences, using skis instead of wheels as the support elements for the vehicle, represent obvious modifications taught by Volz (-501) wherein it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have substituted skis in place of the wheels at the front and rear of the vehicle as suggested by Volz at lines 11-20.

Response to Argument

17. Applicant's arguments with respect to the claims rejections based on 35 USC 102 and 103 have been considered but are not persuasive.

Regarding Applicant's argument that the prior art does not disclose front or rear hub and spindle assemblies integral with a front or rear axle, the examiner replies that, in the absence of clear requirement for interpreting the claim language in accordance with the definition of terms provided in the specification, as by the use of "means-for" language under 35 USC 112, Sixth

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Paragraph, it is incumbent upon the examiner to interpret the language in the broadest reasonable meaning of the word(s). The standard English definition of “hub” is as “the central part of a circular object (as a wheel)”; “axle” is understood to be a “pin or shaft on or with which a wheel revolves”; and “spindle” is something shaped like a spindle (a round stick with tapered ends), or “the part of an axle on which a vehicle wheel turns”. *Merriam-Webster’s Collegiate Dictionary*, Tenth Edition; 1998.

Regarding Applicant’s argument that the prior art does not disclose a chassis configuration that causes a rider to be oriented in a prone, face-down, face-forward position or in any particular orientation, the examiner replies that the claim recitation(s) alluded to by Applicant are interpreted as functional limitations which are recitations in the claims which attempt to define the invention by what it does or by a property or characteristic it has, rather than what it is (i.e., its specific structure or ingredients). As such, functional language, by itself, does not serve to distinguish and is given little patentable weight. If a functional limitation is capable of being performed by the prior art structure, then it can be said to meet the limitations of the claim. In order to be given patentable weight, a functional recitation must be expressed as a “means” for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Regarding Applicant’s arguments relative to rejections under 35 USC 103 (obviousness) based on combinations of prior art references, the examiner replies:

(a) in arguing the references separately, Applicant misstates the criterion for obviousness. It has been held that the test for obviousness is not whether the features of one reference may be

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bodily incorporated into the other to produce the claimed subject matter, but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969); and,

(b) in response to the argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

Regarding Applicant's arguments relative to the nonstatutory double patenting rejection, Applicant relies upon the alleged deficiencies of Volz (US 1,409,501), stating that Volz does not disclose or suggest front of rear hub and spindle assemblies integral with a front or rear axles to which the wheels or runners of the coaster of Volz could be attached. The examiner replies that Applicant misrepresents the rejection. In the rejection of the Office Action for double patenting, the base reference is the Applicant's patent US 6,276,700, which discloses a gravity-driven steerable vehicle having all of the claimed limitations of the claims of the instant application except that it uses wheels front and rear rather than skis front and rear. In this rejection under 35 USC 103 of the Office Action, the prior art of Volz clearly teaches that, for a gravity driven

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steerable vehicle, the use of wheels on the front and rear is interchangeable with the use of skis on the front and rear.

Action made Final

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Prior Art made of Record

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art shows gravity drivent vehicles: Moore teaches apparatus for converting the sled runners to wheels; Lambert teaches convertible skis and wheels front and rear mounted on spindle assemblies; Caughrean teaches skis front and rear mounted with spindles on hubs; Jacobson teaches conversion of runners to skis; Hellstern teaches that "skis" as "runners" are synonymous terms in the art; Hendrickson teaches use of shock absorbers on the ski mounts; West et al. teaches a ski mounting suspension; Stevens shows a bobsled frame and suspension elements for the runners; Anderson teaches a wind powered ski vehicle having the skis mounted

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on spindles at the hubs of the axles and convertible to a wheeled version. These references also show other structures in common with some other features of the inventive concept of the instant application.


Conclusion

20. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 703-308-2560.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 16 March 2004


CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show **current changes**) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]])**; and (2) **if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])**. **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)**. An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

H03258.03

07/2003

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- (4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.